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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,030	01/17/2006	Angelo Ariotto	09728.0350USWO	9357
23552 7590 07/24/2009 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER FISHER, ABIGAIL L	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 07/24/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/566,030	ARIOTTO ET AL.	
	Examiner	Art Unit	
	ABIGAIL FISHER	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/17/06, 3/16/07</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-10 are pending.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 1/17/06 and 3/16/07 were considered by the examiner.

Election

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: amino acid (claim 5), protein or peptide (claim 6) or sarcosinate (claim 7).

Applicant is required, in reply to this action, to elect a single disclosed species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are

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added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1-4 and 8-10.

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all, inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any). Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The common technical feature in all groups is N-acylated amino acids. This element cannot be a

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special technical feature under PCT Rule 13.2 because the element is shown in the prior art. Willman et al. (WO 95/33025) discloses exemplifies N-acylated amino acid (sarcosinate) in detergent compositions comprising fatty acids.

The Applicant is therefore required to elect a **single disclosed species of** amino acid (claim 5), protein or peptide (claim 6) or sarcosinate (claim 7).

Applicant should be aware that a combination not specifically disclosed might be considered new matter.

Applicant is advised that the reply to this requirement to be complete **must** include(i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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During a telephone conversation with Greg Sebold on June 25 2009 a provisional election was made without traverse to prosecute the invention of claim 7 (sarcosinate). Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Therefore, claims **1-4 and 7-10** are examined on the merits herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required

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feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims **1 and 10** recite the broad recitation cleansing composition, and the claims also recite particularly for cleansing skin and/or hair which is the narrower statement of the range/limitation. Additionally, claim **9** recite the broad recitation non-ionic ethoxylated surfactant, and the claim also recites preferably an ethoxylated fatty alcohol which is the narrower statement of the range/limitation.

The term "substantially anhydrous" in claim **1** is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "substantially anhydrous" indicates a certain range is acceptable. However, the specification does not discuss nor contemplate what is the minimum or maximum range for "substantially anhydrous".

Claims 2-4 and 7-8 are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-4, 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Willman et al. (WO 95/33025).

It is noted that the instant claims possess two embodiments, those which read on substantially anhydrous and those which read on a moisture content of less than 10%. Both interpretations are rejected over Willman et al. with the 102 rejection based on the

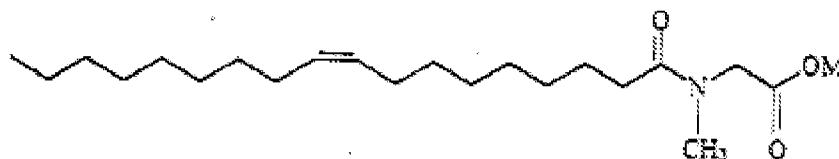
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claim language of substantially anhydrous and the 103 rejection based on the claim language of a water content of no greater than 10%.

102 Rejection

The instant application claims a cleansing composition comprising 10 to 90% by weight of one or more oily substances and 2 to 80% by weight of N-acylate amino acid, proteins and peptides wherein the composition is substantially anhydrous or has a water content of no greater than 10% by weight of the composition.

Willman et al. exemplify a dishwashing detergent composition (i.e. a cleansing composition) comprising oleoyl sarcosinate in 3 to 10 % by weight of the composition. The compositions additionally comprise C₁₂-C₁₆ fatty acids in 6.8 to 14% (wherein the 14% reads on the instant claims). Example 1D comprises 10% oleoyl sarcosinate and 14% C₁₂-C₁₆ fatty acids. Exemplified formulations comprise additional surfactants such as ethoxylated alcohols. It is taught that the oleoyl sarcosinate has the following formula (page 3):



Preferred M substituents are hydrogen and alkali metal cations, especially sodium and potassium. Oleoyl sarcosinate is commercially available, for example as Hamposyl O marketed by W. R. Grace & Co.

Regarding the claimed oily substances, instant claim 8 indicates oily substance includes fatty acids therefore the C₁₂-C₁₆ fatty acids read on the oily substances.

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The exemplified formulation of 1D which comprises 11.35% water would read on substantially anhydrous. Since the instant application provides no definition of substantially anhydrous but the instant claims recite the composition is substantially anhydrous or has a water content no greater than 10% by weight (which is inclusive of 0 to 10%), the examiner interprets substantially anhydrous to mean greater than 10% water but less than 49% water. This interpretation is based on the fact that the instant claims indicate that substantially anhydrous has a different meaning than no greater than 10% water and more than 49% would not be substantially (i.e. more than half) anhydrous.

Regarding claim 4, the oleoyl sarcosinates are either acids (wherein M is H) or alkyl metal cations (sodium and potassium). Since there are three specific forms of the oleoyl sarcosinate taught, one of ordinary skill in the art would immediately envision utilizing any of the three oleoyl sarcosinates.

103 Rejection

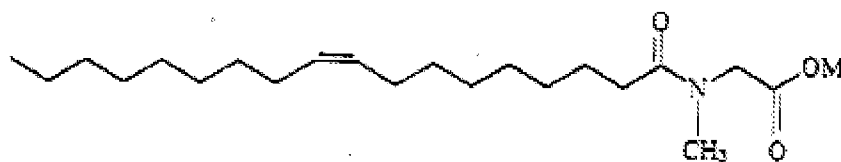
Applicant Claims

The instant application claims a cleansing composition comprising 10 to 90% by weight of one or more oily substances and 2 to 80% by weight of N-acylate amino acid, proteins and peptides wherein the composition is substantially anhydrous or has a water content of no greater than 10% by weight of the composition.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

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Willman et al. exemplify a dishwashing detergent composition (i.e. a cleansing composition) comprising oleoyl sarcosinate in 3 to 10 % by weight of the composition. The compositions additionally comprise C₁₂-C₁₆ fatty acids in 6.8 to 14% (wherein the 14% reads on the instant claims). Example 1D comprises 10% oleoyl sarcosinate and 14% C₁₂-C₁₆ fatty acids. It is taught that the detergent compositions can be used to pretreat substrates. The form would be that of an aqueous paste which contains from about 1 to about 50% water preferably from about 5 to 20% water (page 16, lines 21-30). It is suggested that the detergent composition comprise oleoyl sarcosinate in an amount from 0.1 to about 80% of the composition with most preferably amount of about 2 to about 30% of the composition (page 3, lines 1-5). Exemplified formulations comprise additional surfactants such as ethoxylated alcohols. It is taught that the oleoyl sarcosinate has the following formula (page 3):



Preferred M substituents are hydrogen and alkali metal cations, especially sodium and potassium. Oleoyl sarcosinate is commercially available, for example as Hamposyl O marketed by W. R. Grace & Co.

The forms of the detergents include liquid, gel or granular forms. Granular forms have low level of residual moisture (5 to 12%) (column 14, lines 32-34).

Regarding the claimed oily substances, instant claim 8 indicates oily substance includes fatty acids therefore the C₁₂-C₁₆ fatty acids read on the oily substances.

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**Ascertainment of the Difference Between Scope of the Prior Art and the Claims
(MPEP §2141.012)**

Although Willman et al. teach the compositions can comprise low amounts of water and exemplify a formulation comprising 11.35% water; Willman et al. do not exemplify a formulation comprising less than 10% water.

***Finding of Prima Facie Obviousness Rationale and Motivation*
(MPEP §2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to manipulate the formulation and utilize less than 10% by weight of water. One of ordinary skill in the art would have been motivated to manipulate the water content depending on the desired form of the cleaning composition. Willman et al. teach that granular forms have low levels of residual moisture and that the compositions when utilized as a paste have water amounts of about 5 to 20%, which overlaps that instantly claimed. Therefore, based on the teachings of Willman et al. it would have been obvious to one of ordinary skill in the art to manipulate the formulation and utilize less than 10% by weight of water.

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knochel et al. (US Patent No. 4946618) in view of Kacher et al. (US Patent No. 5227086).

Applicant Claims

The instant application claims a cleansing composition comprising 10 to 90% by weight of one or more oily substances and 2 to 80% by weight of N-acylate amino acid, proteins and peptides wherein the composition is substantially anhydrous or has a water content of no greater than 10% by weight of the composition.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Knochel et al. is directed to a toilet soap bar composition cationic guar gum. The toilet bar soap comprises from about 0.2 to about 5 % by weight cationic guar gum (column 2, lines 46-48). The soap component comprises from about 50 to 90% by weight alkali metal soap of fatty acids containing from about 8 to about 24 carbon atoms (column 2, lines 66-68 to column 3, lines 1-39). The soap bar comprises about 50% soap as its primary or sole surfactant (column 3, lines 62-63). Exemplified amounts are 54.5 %. The soap bar additionally comprises synthetic detergents such as nonionic synthetic detergents like ethoxylated fatty alcohols (column 4, lines 46-52). The water content of the depending on the surfactant can be as little from 3.5 to 4.5% water and generally from about 8 to about 20% water with 7 to 15% and 8 to 12% being specifically claimed (column 6, lines 1-3 and claims 10-11). The soap bars preferably contain up to 20% of a synthetic surfactant, preferably a mild one (column 6, lines 59-

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61). Examples of mild surfactants include anionic acyl sarcosinate (column 7, lines 6-20).

**Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)**

While Knochel et al. teach that the soap bar additionally comprises synthetic detergents such as nonionic synthetic detergents like ethoxylated fatty alcohols; Knochel et al. do not exemplify bars with this detergent.

While Knochel et al. teach that the surfactant can be an acyl sarcosinate, Knochel et al. do not exemplify utilizing an acyl sarcosinate as the surfactant or that the acyl sarcosinate is cocyl sarcosinate. However, this deficiency is cured by Kacher et al.

Kacher et al. is directed to a cleansing bar. It is taught that hygroscopic surfactants help to improve bar lather (column 2, lines 23-29). Examples of hygroscopic surfactants include sarcosinates such as lauryl sarcosinate, stearyl sarcosinate, and cocoyl sarcosinate including sodium salts (Table, column 12).

***Finding of Prima Facie Obviousness Rationale and Motivation*
(MPEP §2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Knochel et al. and Kacher et al. and utilize cocoyl sarcosinate as the surfactant in the toilet bar. One of ordinary skill in the art would have been motivated to utilize cocoyl sarcosinate as Knochel et al. teach that acyl sarcosinates can be utilized and Kacher et al. teach that cocoyl sarcosinate which is a particular acyl sarcosinate is a hygroscopic surfactant which helps to improve bar lather. Therefore, one of ordinary skill in the art would have been motivated to utilize

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the acyl sarcosinate cocoyl sarcosinate for improved bar lather as taught by Kacher et al.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Knochel et al. and Kacher et al. and utilize an ethoxylated fatty alcohol as the synthetic detergent. One of ordinary skill in the art would have been motivated to utilize an ethoxylated fatty alcohol as it is a specific detergent taught. It would have been obvious to one of ordinary skill in the art to try the specifically taught detergents as a person with ordinary skill has good reason to pursue known options within his or her technical grasp. **Note: MPEP 2141 [R-6] KSR**
International CO. v. Teleflex Inc. 82 USPQ 2d 1385 (Supreme Court 2007).

Regarding the claimed oily substance, Knochel et al. teach a bar comprising 50% soap of which 50 to 90% is a fatty acid. Fatty acid is a particular claimed oily substance and 50 to 90% of 50% is 25 to 45% fatty acid which reads on instant claims 1 and 2.

Regarding the claimed water content, Knochel et al. teach an amount that overlaps that instantly claimed. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5].**

Regarding the claimed amount of surfactant, Knochel et al. teach an amount of up to 20%, which overlaps that instantly claimed. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5].**

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher
Examiner
Art Unit 1616

AF

/Mina Haghighatian/
Primary Examiner, Art Unit 1616

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